

REMARKS

This is in response to the election requirement imposed by the Examiner in the communication mailed January 12, 2005. The Examiner identified two patentably distinct species of the claimed invention: Species I corresponding to FIGS. 5 and 6, and Species II corresponding to FIGS. 7 and 8.

Election Requirement

Applicant hereby elects, with traverse, to prosecute Species I corresponding to FIGS. 5 and 6. Presently, claims 1-18 and 20-24 read on Species I. Additionally, claims 10, 14 and 20 are generic as lacking a reading element, and claim 22 is generic since it does not describe the claimed reading element as having a particular location relative to the writing element.

CFR § 142(a) second sentence states: "[i]f the distinctness and independence of the invention be clear, such requirement will be made before any action upon the merits; however, it may be made at any time before final action in the case at the discretion of the examiner." In accordance with MPEP 811, "[t]his means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops."

The prosecution history of this application includes the following Actions from the Examiner:

- an Office Action of June 19, 2003;
- an Office Action of March 24, 2004;
- an Advisory Action of June 24, 2004;
- an Office Action of August 26, 2004;
- a Supplemental Office Action of September 14, 2004; and
- the present Election Requirement.

The original application included claims directed to both Species I and Species II identified by the Examiner and the Examiner has examined both Species in each of the above-identified Office Actions, except the present Election Requirement. Applicant submits that the election requirement is improper since it should have been made almost a year and a half ago in the Office Action of June 19, 2003 rather than in the present action.

MPEP 811 states that "[b]efore making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required." Accordingly, if the Examiner would not avoid a serious burden by imposing a restriction requirement after the first action, the restriction should not be required.

In this case, the imposition of an election requirement at this time would not avoid a serious burden on the examiner. In particular, any "serious burden" that exists today, was accepted by the Examiner as evidenced by the prosecution history of the present application. More particularly, claims to both Species I and Species II have existed in the application from the beginning. Additionally, in each of the Office Actions identified above, the Examiner was able to locate art that he found sufficient to reject all of the claims including those directed to Species I and Species II.

Furthermore, Applicant submits that it is improper to impose the election requirement at this time since, according to 37 C.F.R. §1.146, the examiner, "[i]n the first action . . . may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable." Additionally, Applicant submits that the existence of two species of the invention is not "more than a reasonable number of species", thereby rendering an election requirement at this late

stage of prosecution unjustifiable, particularly when the Examiner had the opportunity make the requirement in the very first Office Action dated nearly a year and a half ago.

Moreover, the imposition of the election requirement at this late period in the prosecution of this case creates a serious burden on Applicant. In particular, the Examiner has failed to address any of Applicant's arguments that have been presented thus far regarding the rejections of the claims. For example, even though Applicant explained with particularity why the Examiner's rejections presented in the Office action of March 24, 2004 were improper, the Examiner maintained the same rejections in the Office Action of August 26, 2004 without addressing a single issue raised by Applicant. Accordingly, Applicant submits that any burden faced by the Examiner is significantly outweighed by the serious burden on Applicant that would result from further delay in the prosecution of this case.

For the reasons set forth above, Applicant submits that the election requirement is improper, and requests that the election requirement be withdrawn and that all pending claims be considered by the Examiner.

#### Amendments

With this Amendment, Applicant has amended some of the claim language used to describe the relative positions of the return and main poles based on a stylistic preference of the Examiner as presented during a telephone interview of February 3, 2005. In general, Applicant submits that there is no substantive difference between the manner in which Applicant previously described the relative positions of the main and return poles with reference to the moving magnetic medium and the presently amended form of independent claims 1, 10, 14 and 20. For example, with regard to independent claim 1, Applicant submits that there is no substantive difference between the previous claim language

of "a return pole tip located downstream of the main pole relative to the moving magnetic medium" and the presently amended form of "a return pole tip positioned from the main pole in the first direction" [in which the magnetic medium is moving].

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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